

## **REMARKS**

### **I. Amendments to the Claims:**

Claims 14-35 and 37-53 are in the application. Claims 14-20, 22, 25-35, 37 and 47-53 are amended. Claims 1-13, 21, 23, 24, and 36 are cancelled. No additional claim fees are believed required.

Applicants note that the claim amendments requested in the After Final Amendment and Response of June 14, 2006, as noted in the Advisory Opinion, were not entered, and hereby request non-entry of such amendments. The amendments to the claims herein pertain to the claims present in the application at the time of the Final Action on April 14, 2006.

Claims 14-20, 22, 25 and 27-33 have been amended to replace the term “pre-baked” with the term “bakeable,” or added to correct antecedent basis. Support is found in the description at paragraph [0005], line 3. The amendment is made to more particularly defined and distinctly claimed the claimed compositions.

Claim 25 is also amended to replace the phrase “a plurality of spaced-apart beads” with --parallel bead formations--. The Applicant believed that the phrase “a plurality of spaced-apart beads” was adequately supported by the description and by an appropriate dictionary meaning of the term “bead” (see page 13, first full paragraph of Applicants January 31, 2006 Response). Nevertheless, Applicant wishes to amend the claim to provide direct support in the description and figures. Support for the phrase --parallel bead formations-- is found in paragraph [0045], which refers to an earlier described composition applied with an applicator, at paragraph [0035] and Figure 12.

Claims 27-31 are amended to replace the term “beads” with --bead formation-- to match the antecedent basis.

Claim 26 is amended to indicate the antecedent basis to the “extruded” composition in Claim 25.

Claim 34 and 37 is also amended to replace the phrase “the form of beads” with --parallel bead formations--.

Claims 34, 35 and 37 are amended to correct the antecedent basis of the aqueous polymeric composition.

Claim 47 is amended to replace the term “pre-baked” with --bakeable--. Support for identifying the sound-damping composition as “bakeable” is found in paragraph [0005], line 3.

Claims 48-53 are amended to correct the antecedent basis to “the bakeable” sound-damping composition.

No new matter is believed to have been introduced by the above amendments. Applicants respectfully request entry of the claim amendments.

## **II. Response:**

Applicants’ Attorney wishes to thank the Examiner for her courteous and helpful telephone interview on June 7, 2006.

Claims 14-33 and 47-53 are rejected under 35 USC 112, first paragraph, for use of the term “pre-baked” to describe the sound-damping compositions. Applicants request reconsideration and withdrawal of the rejection in view of the amendments and the comments that follow.

Applicants believe that the term “bakeable” is synonymous with the term “pre-baked” as used at paragraph [0008] line 3. The compositions disclosed in the specification are either “bakeable” or “baked”. The “bakeable” composition can also generally be referred to as either “pre-baked”, “extruded”, or “aqueous polymeric”. The “baked” composition is obtained when any of the bakeable, pre-baked, extruded, or aqueous polymeric compositions is subjected to elevated temperatures to exhaust or remove moisture therefrom.

Claim 25 was similarly rejected for failing to have support in the specification for the amendment “plurality of spaced-apart beads”. Applicants request reconsideration and withdrawal of the rejection in view of the amendments and the comments that follow.

Applicants have amended the phrase “plurality of spaced-apart beads” to --parallel bead formations--, and note that the phrase “parallel bead formations” finds direct support in the description at paragraph [0045], which references to the previously described applying of the compositions at paragraph [0035] and Figure 12.

Claim 35 was rejected under 35 USC 112, second paragraph, for lacking antecedent basis for the term “pre-baked”. Applicants have amended the phrase “pre-baked sound-damping composition” to read --aqueous polymeric composition-- to establish proper antecedent basis. Applicants request withdrawal of this rejection.

Claims 14-35 and 37-53 are rejected under 35 USC 102(e) as anticipated by, or in the alternative, under 35 USC 103(a), as obvious over, LaStarge, U.S. Patent 6,872,761. [Note: Claims 21, 23 and 24 are cancelled.]

Applicants traverse the rejection under 35 USC 102(e) and 35 USC 103(a) as to Claims 14-20, 22 and 47-53 on the basis of the Declaration under 37 CFR 1.131 submitted in the Response dated January 31, 2006, and the remarks submitted therewith, and the further remarks that follow.

The Applicants presented in the Response dated January 31, 2006 a Declaration under 37 CFR 1.131, that demonstrates by facts that the inventions directed to the sound-damping compositions and bakeable sound-damping compositions that are embodied in Claims 14-20, 22 and 47-53, were conceived and reduced to practice in the U.S. by the Applicants before the effective date of the LeStarge publication; that is, before April 24, 2003. (Applicants wish to confirm that only a 131 Declaration was submitted in the last response. There was not submitted a 132 Declaration as wrongly noted on the last page of the last response.)

The Declaration identifies the claimed sound-damping compositions as bakeable and in the alternative, as “pre-baked” (see the 131 Declaration at Section 5, second line). Note also that the Invention Record 02-002 document annexed to the Declaration, is entitled “Bakeable Lightweight Waterbase Sound Deadener.” Applicants assert that a “bakeable sound damping compositions” is that composition before baking, whereby the terms “bakeable” and “pre-baked” sound damping composition, and their use in the Declaration, are synonymous.


Having sworn behind the LeStarge reference with the 131 Declaration, Applicants request withdrawal of the rejection against Claims 14-20, 22 and 47-53.

Applicants also request reconsideration of the rejection of Claims 25-35 and 37-46 in view of the amendments made thereto and the remarks that follow. Independent Claims 25 and 37 provide methods that include the step of extruding the sound-damping composition or aqueous polymeric material, respectively, onto a substrate in “parallel bead formations”, and specifically in Claim 37 as bead formations having a width of about 1-12 mm, and a thickness of about 1-3 mm, with a spacing of less than about 2 mm between the bead formations. Applicants contend that the disclosure of LeStarge neither discloses nor suggests application of the wet composition in parallel bead formations. As disclosed in paragraph [0035] and illustrated in Fig. 12 of the present application, applying the composition in spaced-apart parallel bead formations

enables a controlled rate of drying at high surface weights of the material. The spaced-apart bead formations provide a large exposed surface area, which provides controlled drying rates without compromising sound transmission loss and damping properties of the composition. Applicants contend that there is no teaching in LeStarge that either discloses or suggests extruding the composition onto a substrate as parallel bead formations, or the advantage obtained therefrom. Applicants respectfully request withdrawal of the rejection against Claims 25-35 and 37-46.

Applicants believe it has provided a complete response to the last Office Action (After Final) and that the amendments, 131 Declaration and remarks herein clearly distinguish the claims from, or swear behind, the cited art. Applicants therefore respectfully request withdrawal of all rejections, and allowance of all claims as amended.

Respectfully submitted,

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